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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,315	05/16/2005	Zhicheng Shen	60163USPCT	2385
22847 7590 07/17/2007 SYNGENTA BIOTECHNOLOGY, INC. PATENT DEPARTMENT 3054 CORNWALLIS ROAD P.O. BOX 12257 RESEARCH TRIANGLE PARK, NC 27709-2257				
			EXAMINER KUBELIK, ANNE R	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,315

Applicant(s)

SHEN ET AL

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49,58-62,73-78,80,90,95,97 and 98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49,58-62,73-78,80,90,95,97 and 98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 49, 58-62, 73-78, 80, 90, 95 and 97-98 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of claims 49, 58, 80, 90, 95 and 97-98 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a toxin of SEQ ID NO:2, 11 or 32 and methods of using it to control pests, does not reasonably provide enablement for toxins with 97% identity to SEQ ID NO:2 and with a C-terminus comprising amino acids 661-788 of SEQ ID NO:2, and methods of using the toxins to control pests is withdrawn due to Applicant's amendment of the claims and Applicant's arguments filed 30 April 2007.
4. The rejection of claims 49-50, 55-58, 63-64, 69-72, 80, 90, 95 and 97-98 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as detailed in the Office action mailed 24 January 2007 is withdrawn due to Applicant's amendment of the claims.
5. The rejection of claims 71-72 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schnepf et al (US Patent 6,369,213, filed July 1997) is withdrawn due to Applicant's amendment of the claims.
6. The rejection of claims 49, 70, 80, 90, 95 and 97-98 under 35 U.S.C. 102(e) as being anticipated by Schnepf et al (US Patent 6,369,213, filed July 1997) is withdrawn due to Applicant's amendment of the claims.
7. The rejection of claims 49, 55-58, 70, 80, 90, 95 and 97-98 under 35 U.S.C. 103(a) as being unpatentable over Schnepf et al (US Patent 6,369,213, filed July 1997) in view of Stemmer

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et al (US Patent 6,500,617, filed May 1998) is withdrawn due to Applicant's amendment of the claims.

Claim Rejections - 35 USC § 112

8. Claims 49, 58-62, 73-78, 80, 90, 95 and 97-98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Neither the instant specification nor the originally filed claims appear to provide support for the phrase "wherein said toxin comprises an amino acid sequence that has at least 97% sequence identity with SEQ ID NO:2 and wherein the C-terminus of said toxin comprises amino acids 661-788 of SEQ ID NO:2".

The pages of the specification cited in the response filed 30 April 2007 as providing support do not. Pgs 53-54 of the specification show that proteins comprising amino acids 661-788 of SEQ ID NO:2 are sufficient for toxicity. Neither SEQ ID NO:11 or 32 comprise amino acids 661-788 of SEQ ID NO:2 (See Applicant's exhibit A at amino acid 737). Even if they had amino acids 661-788 of SEQ ID NO:2 as well as the 97% overall identity to SEQ ID NO:2, this would not provide support for claims to any toxin with 97% sequence identity to SEQ ID NO:2 and with a C-terminus comprising amino acids 661-788 of SEQ ID NO:2.

The originally filed claims also do not provide support for this percent identity and for the protein also comprising amino acids 661-788 of SEQ ID NO:2.

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Thus, such a phrase constitutes NEW MATTER. In response to this rejection, Applicant is required to point to support for the phrase or to cancel the new matter.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

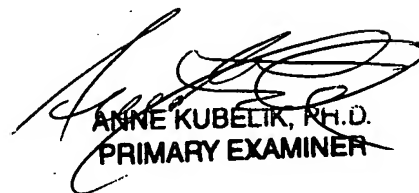
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.
July 12, 2007


ANNE KUBELIK, Ph.D.
PRIMARY EXAMINER